



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

Ch

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,316	02/15/2002	Geoffery Wilson	1512.2.105	9859

21552 7590 04/29/2003

MADSON & METCALF
GATEWAY TOWER WEST
SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT	PAPER NUMBER
----------	--------------

3711

DATE MAILED: 04/29/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/077,316

Applicant(s)

WILSON, GEOFFERY

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 3, 15, 16 and 20-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 9-14 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Claims 15-16 and 20-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5. In addition, claim 3 is directed to the inner shaft part having a split end which is received within the internal tube which is not the elected species as shown in figure 2. Figure 2 shows the internal tube being received within the inner shaft part. As such claim 3 is also withdrawn from consideration for not being directed to the elected species. Claim 12 is being considered due a generic claim 6 having allowable material. Claim 15-16 are not being considered due to these claims being directed to the embodiment of figure 5 yet the claim these claims depend on claim 6 requires a deformable component. The embodiment of figure 5 does not disclose any deformable component. It is uncertain why claims 15-16 are dependent on claim 6.

Specification

2. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

Art Unit: 3711

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

The specification is without section headings as disclosed above.

Claim Rejections - 35 USC § 112

3. Claims 5-6, 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 is indefinite in that the statement "the

Art Unit: 3711

expander control member can be moved between a locked position in which the expander is withdrawn into the end of the inner tube part" does not make sense. In the locked position it is believed that the expander is not withdrawn into the end of the inner tube part but drawn into the end of the inner tube part. Claim 10 is indefinite in that the units $MN.m^{-2}$ is not understood. It is uncertain what the M stands for and what the period means. Claims 6 and 12 are indefinite in that in claim 12 it states "the resiliently deformable component which biases the movable member towards the locking position is the expander control member" yet the claim it depends on claim 6 states "the expander control member is biased towards the locked position by a deformable component acting against a stop". In claims 6 and 12 it is uncertain if these are two components or one. In this case, it is recommended not calling the same part two different names because it causes confusion especially for claim 6. Claim 13 is indefinite in that the moveable member is threaded leading one to believe the moveable member is the screw (6) yet in claim 11 which claim 13 depends the moveable member is biased towards the stop when the expander control member is in the locked position leading one to believe the spring is connected to the moveable member and it must be the head (24). However this head (24) is not known to have threads. So in claim 13 it is not certain what the moveable member is. Claims 11 and 14 are rejected for depending on a rejected base claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-2, 4-5, 9, and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Andis.

Andis discloses a golf club with an adjustable shaft, an inner shaft part (2), an outer shaft part (30), a locking mechanism comprising an inner tube part (10) which has a split end (Fig. 5) and an outer tube part in the form of an inner shaft part (2) which can receive the split end of the inner tube part (Fig. 2), an expander (15), an internal tube (10) fastened within the outer shaft part (30) and extending along the inside of the outer shaft part (Fig. 2, Col. 1, Lns. 66-71), the internal tube having split end (Fig. 5) which is received within the inner shaft part (2), an internal tube providing an inner tube part (10), the inner shaft part (2) providing the outer tube part of the locking mechanism (Fig. 2), a control member (16) for controlling the position of the expander relative to the split end (Fig. 2), an expander control member can be moved between a locked position in which the expander is withdrawn into the end of the inner tube part to cause its end to become splayed, and an unlock position in which the expander is not located tightly within the splayed end (Col. 2, Lns. 14-21), a tension adjuster (21) for setting the expander control member stress when the locking mechanism is in its locking position (Fig. 2), and the

locking mechanism able to be operated from outside an outer shaft part in the form of using a screw driver (Fig. 2).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Andis.

Andis does not specifically state the amount of stress on an expander control member when the locking mechanism is in its locked position but clearly an artisan skilled in designing a locking mechanism to ensure the projections (expander control member, Ref. No. 16) is tightly drawn into the slots to cause the end of the inner tube to flare would have selected a suitable stress to apply to the screw and thus the expander and projections within the slots in which 100MN/m^2 is included.

Andis lacks the stress on an expander control member when the locking mechanism is in its locked position being at least about 100MN.m^{-2} .

It would have been obvious to modify the adjustable shaft of Andis to have the stress on an expander control member when the locking mechanism is in its locked

position being at least about 100MN.m^{-2} in order to ensure the expander flares out the ends of the inner end of the inner tube part.

Allowable Subject Matter

8. Claims 6 and 11-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. With respect to claims 6 and 11-16, none of the prior art discloses or renders as obvious the expander control member being biased towards the locked position by a deformable component acting against a stop in addition to the other elements of structure claimed.

9. Claims 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. With respect to claims 7-8, none of the prior art discloses or renders as obvious a resiliently deformable spring element which is deformed when the locking mechanism is in its locking position to place the expander control member under load in addition to the other elements of structure claimed.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the

Art Unit: 3711

examiner should be directed to Steve Blau whose telephone number is (703) 308-2712.

The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Paul Sewell whose telephone number is (703) 308-2126. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858.

Slb 21 April 2003



STEPHEN BLAU
PRIMARY EXAMINER